

Appl. No. : 10/820,848 Confirmation No. 8673
Applicant : Lawrence V. Tannenbaum
Filed : April 09, 2004

TC/A.U. : 1631
Examiner : LIN, J.

Docket No. : CHPPM 03-22 03
Customer No. : 27370

For: METHOD FOR FIELD-BASED ECOLOGICAL RISK
ASSESSMENT USING RODENT SPERM ANALYSIS

ELECTION AND TRAVERSE

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement of September 28, 2006, Applicant elects to prosecute Group I (Claims 1-12) subject to the traverse. Applicant further elects Species A (Claim 4) directed to measuring sperm count without traverse.

The present restriction is between two allegedly distinct inventions: (1) a method for assessing ecological risk to receptors (Group 1); and (2) a method for assessing ecological risk to receptors by removing the epididymis from rodents (Group 2).

According to M.P.E.P. 806.05(j), related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants.

The requirements of M.P.E.P. 806.05(j) are not met. The inventions of Group I and Group II have similar modes of operation (obtaining rodents from contaminated sites, such as sites including at least 2 burning pads with high

hazard quotients for at least one chemical, and obtaining rodents from animal reference sites); similar functions (conducting rodent sperm analysis, such as assessing sperm motility, sperm count, or sperm morphology), and similar effects (assessing ecological risk to receptors). Thus, the inventions of Group I and Group II are capable of use together and are not mutually exclusive.

In addition, Applicant respectfully notes that the burden is on the Examiner to provide an example to support the determination that the inventions are distinct. The Examiner has not provided any example, but merely states that "the method steps are different" (Office Action at page 2). The inventions clearly overlap in scope, with Claim 13 (Group II) being a narrower process than the related invention recited in Claim 1 (Group I). In fact, each of the broad method steps of Claim 1 (Group I) is also recited in Claim 13 (Group II) with additional claim limitations.

Applicant respectfully asserts that search and examination of Group I would necessarily include consideration of the subject matter of Group II, without imposing an undue burden on the Examiner. As Section 803 of the M.P.E.P. requires,

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

It is respectfully urged that the restriction requirement is improper because the Examiner has not shown that a search and examination of the entire application would, indeed, cause a *serious* burden, as required by Section 803 of the M.P.E.P.

In view of the foregoing, Applicant requests reconsideration of the restriction requirement and submits that the application is now in condition for substantive

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examination of all claims on the merits. Therefore, Applicants request favorable consideration of the application.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

Respectfully submitted,
CAHN & SAMUELS, LLP

/Warren A. Zitlau/

October 10, 2006

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